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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,721	01/24/2001	Tatsuhiko Ikuta	1614.1115	3663

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EXAMINER

ALPERT, JAMES M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/767,721

Applicant(s)

IKUTA, TATSUHIKO

Examiner

James Alpert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☒ Claim(s) 1-2 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 24 Jan. 2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Objections***

Claim 1 and 2 are objected to because of the following informalities:

the term "properlity" is used in Claims 1 and 2.

This term has no accepted meaning in the English language. The examiner is treating this term as a typographical error of the word "property," and will examine the claims accordingly. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2-5 are rejected under 35 U.S.C. §101 because the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble and the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. §101. In contrast, a method claim that includes in the body of the claim, some structural / functional interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

Claims 2-5 are directed toward an accounting method. However, the preamble and the body of the claims do not indicate that a computer system executes the method. In order to over come the 101 rejections above, the following preamble is suggested:

A computer implemented method for ---, or something similar.

Also, in the body of the claim include some structural / functional interrelationship which can only be computer implemented

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Michel et al, U.S. Patent #5625690.

**With regard to Claims 1 and 2**, Michel teaches the system and method comprising:

a) reporting registration certification to an accounting server from a terminal device when contents to be charged for are accessed in said terminal device, which is previously registered in said accounting server; (Col. 4, lines 55-66)

b) confirming property of the reported registration certification in said accounting server, and performing fee charging; and (Col. 8, lines 14-32)

c) when the property of the registration certification is confirmed, reporting permission of access to the contents, from said accounting server to said terminal device, and making the contents accessible in said terminal device. (Col. 5, lines 4-29)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 3-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michel et al., U.S. Patent #5625690 in view of Taskett, U.S. Patent #5991748.

**With regard to Claim 3,6, and 10,** Michel teaches the method, device and medium comprising:

determining whether or not a condition for accessing contents is satisfied, when the contents are accessed; and (Col. 9, lines 43-49)

enabling the access to the contents when the condition for accessing the contents is satisfied, (Col. 11, Claim 10)

Taskett does not expressly disclose the following limitations:

enabling the access to the contents after performing fee charging when the condition for accessing the contents is not satisfied.

However, in an analogous case involving access to cellular phone use, Taskett does disclose fee charging on a failed condition at (Col. 2, lines 39-49). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Michel, related to a system of pay-per-use software with Taskett, related to a system for conditioned access. The motivation for such a combination is to separate the financial data information from software access

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information, making the system more modular, enhancing upkeep ease as well as overall security

**With regard to Claim 4,7, and 11,** Michel teaches the method, device and medium comprising:

determining whether or not a condition for accessing contents is satisfied;  
(Col. 9, lines 43-49)

Michael does not expressly teach the following limitations:

reporting fee charging to an accounting server when the condition for accessing the contents is not satisfied; and

updating from said accounting server the condition for accessing the contents into a condition such that the contents can be accessed.

These limitations are both described in Taskett at (Col. 2, lines 39-49). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Michel, related to a system of pay-per-use software with Taskett, related to a system for conditioned access with access granted upon an updated accounting. The motivation for such a combination is to separate the financial data information from software access information, making the system more modular, enhancing upkeep ease as well as overall security.

**With regard to Claim 5,9, and 13,** Michel teaches the method, device and medium comprising:

receiving a certificate previously issued for registration information of a terminal device, and determining whether or not the certificate is valid; (Col. 4, lines 55-66)

transmitting the determination result of said step a) to said terminal device, generating information indicating that a condition for accessing contents is satisfied when the determination result is that the certificate is valid, and transmitting the generated information to said terminal device; and (Col. 5, lines 4-29)

Michael does not expressly teach the following limitations:  
charging said terminal device.

However, this limitation is described in Taskett at (Col. 2, lines 39-46). It would have been obvious to one of ordinary skill in the art at the time applicant's invention was made to combine the teachings of Michel, related to a system of registering at an accounting server for a pay-per-use software with Taskett, related to a system for conditioned access with access granted upon charging of a device. The motivation for such a combination is to separate the financial data information from software access information, making the system more modular, enhancing upkeep ease as well as overall security.

**With regard to Claims 8 and 12**, Mikel teaches the device and medium wherein:  
the determining step, accounting step, and updating step are performed on the operating system of the device. (Col. 3, lines 35-43)

### ***Conclusion***

The following prior art, made of record but not relied upon, is considered pertinent to applicant's disclosure:

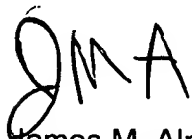
- a) LaDue, U.S. Patent #6088431, July 11, 2000, Method for Transmitting Voice or Data in a Wireless Network Depending on Billing Account Status.
- b) Thomas, U.S. Patent #4685055, August 4, 1987, Method and System for Controlling Use of Protected Software.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Alpert whose telephone number is (703) 305-4001. The examiner can normally be reached on M-F 9:00-5:30. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



James M. Alpert  
March 15, 20005



**ALAIN L. BASHORE**  
**PRIMARY EXAMINER**